

AMENDMENT DOCUMENT

Remarks pertaining to Law of Inherency

As Applicants' Attorney I respectfully take issue with the use of the word "inherent" by the Examiner to suggest a necessary component in the patents of both Scott and Van Lingen, a use to imply a component or use which had obviously been ignored by both Scott and Van Lingen.

The Examiner stated, as to Scott: "a water holding tank 48, 57 connected to a water supply line (inherent because the tanks must be filled by some manner)", and as to Van Lingen: "a water holding tank tank 22 connected to a water supply line (inherent because the tanks must be filled by some manner)".

I quote from the MPEP, Sec. 2112, page 2100-57: "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient".

In the reference material, the Examiner used the statement "the tanks must be filled by some manner" regarding both Scott and Van Lingen. The use of the phrase "by some manner" is completely theoretical.

To be absurdly conclusive, the tanks could be filled by a child given the task of adding water to the tanks by use of a small plastic pail, or, simply by providing a large opening in one side of the tanks to collect rain water, periodically.

Both Scott and Van Lingen had ample opportunity to make a slight means for filling, but, for some reason, completely disregarded the possibility.

Since the word "inherent" is a condition of fact rather than a statement of law, the rule of Equity must be considered in this matter.

In applying Equity, the courts have said, in CJS Patents 145: "Moreover, the PTO must examine, analyze, and evaluate all evidence pertaining to reduction to practice, under the "rule of reason" standard.

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Remarks pertaining to Law of Inherency (cont.)

Thus, in applying the rule of equity, I believe that the use by Applicants; of the descriptive terms "sealably passing thru", "overflow valve", and "switch member" are much more "inherently" related to Applicants' invention than the inherency provided by Scott and Van Lingen.

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Remarks pertaining to 35 USC 102 Rejection on Scott

The Examiner relies on the inclusion of a "source of water" as being "inherent" in the references of both Scott and Van Lingen.

I should like to quote from 69 CJS Patents, Sufficiency of Disclosure: "The prior patent must disclose how the desired result can be obtained. An invention is not anticipated by the earlier issuance of a patent containing a mere suggestion or prophecy of what may be done, what ought to be accomplished, or vague, indefinite, general, or ambiguous references to the subject matter of the invention. Mere reference to the method comprising an invention without description and coupled with the declaration that such a method is inefficient does not amount to anticipation".

Again, under the same section of 69 CJS Patents, the court said: "In order that an invention may be anticipated by a prior patent the latter must disclose the complete and operative invention in such full, clear, and exact terms as to enable any person skilled in the art to which the invention relates (emphasis added), or is most clearly connected, to practice the invention without the exercise of inventive skill of his own; every element or attribute of the invention not obvious to those skilled in the art must be disclosed. Imputing similarity of features to a prior art patent when the patent disclosure teaches otherwise would be inappropriate".

I contend that none of the references cited by the Examiner meets the terms of a 102 Rejection under the decisions given by the courts under those conditions.

For example, Scott does not show any suitable reference or disclosure of a "water supply means". The Examiner has added that the water holding tank of Scott is "connected to a water supply line" as being inherent because the tanks must be filled by some manner.

The suggestion of the "inherent" connection to a water

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Remarks pertaining to 35 USC 102 Rejection on Scott (cont)  
source is not only improper under the rule of Equity, but also fails under the rulings given by the courts as being indefinite and ambiguous.

Further, it is quite clear that Scott had different conditions for the connection of his tank. In Column 2, lines 35-38, he says: "In an operative orientation the storage tank being filled with water, a tank pipe having an inner end coupled within the storage tank and an outer end coupled to the vertical pipe". No thought of any connection to a "water source".

Then, on column 5, lines 50-54, he says: "A tank pipe 54 has a inner end coupled within the storage tank. The tank pipe has a outer end which is coupled to the intake pipe of the pump." Again, there is no suggestion of connection to a water source.

I further quote from Scott in column 5, lines 54-59: "A first alternative embodiment 55 of the apparatus is shown in FIG. 7. In such embodiment, the apparatus includes a subterranean tank 57. In alternate embodiments of the apparatus a storage tank is not included with the system. Rather, a swimming pool or public water source is operatively coupled to the system. Note FIGS. 1 and 2."

However, FIGS. 1 and 2 do not show any of the components or connections.

The Examiner also cited Scott as including "a means for inspecting (short pipe with cap in figure 8)

However, Figure 8 of Scott does not contain any such "means for inspecting for inspecting". Figure is simply a set of box members described by Scott as: "FIG. 8 is a flow chart indicating the sequential operation of an alternate embodiment of the apparatus."

Neither FIG. 6 nor FIG. 8 seem to refer to Scott's apparatus. I note particularly, that FIG. 6 refers specifically to some course of manual activation.

In his lengthy description and claim, Scott had a great deal of opportunity to include even some minor connection to a water source, but quite clearly did not intend to.

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Remarks pertaining to 35 USC 102 Rejection on Van Lingen

The Examiner relies on the inclusion of a "source of water" as being "inherent" in the references of Scott and Van Lingen.

However, I believe that Scott and Van Lingen clearly intended to omit any reference to a "water source" because of the lengthy, extremely detailed, descriptions and claims that each of them exhibited, and, as such, the easy opportunity which had provided them for simple inclusion of brief connections.

Both Scott and Van Lingen quite obviously gave no intent to specify by any means what kind of "source of water" they wanted. To me, it is clear that they did not even consider a "source of water" as part of the invention. They apparently were more interested in describing some form of mechanical apparatus.

I cited above the basics of Equity with regard to "inherent" features.

I maintain that to be "inherent", the "inherent" feature cannot be derived as a cunction of the basic or complete invention. It is inherent only if the "inherency" is a fundamental property of some specific component of the invention.

Scott and Van Lingen do not even include a "source of water" in their Claims. Perhaps, if they had even included a "source of water" in their Claims, some suggestion might be found for an "inherent" connection, but it cannot be an "inherent" quality of the basic invention.

The Examiner refers, in Van Lingen, to "a water holding tank 22 connected to a water supply line (inherent because the tanks must be filled by some manner)". I wish to state again that this is an ambiguous assumption and could not be inherent.

Also, Van Lingen does not provide the same type of sprinkler head components as Applicants. Applicants refer to "adjustable" components. Those of Van Lingen are described as "adapted to spray water upwardly", no mention of adjustability.

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Remarks pertaining to 35 USC 102 Rejection on Banzato

As to the 102 Rejection based on the reference to Banzato, I notice several main distinctions of Applicants' invention from that of Banzato. Banzato does not show sprinkler heads that are "adjustable". Banzato does not provide a means to collect water for return to the water supply, as Applicants have provided by gutter 40 and return water line 44. And, Banzato does not provide a filter as Applicants have provided by filter 50 in return water line 44.

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Remarks in Summary of all 102 Rejections

In summary, I wish to refer to court decisions found in 69 CJS Patents 55 Sufficiency of Disclosure: "Anticipation can be found only when a reference discloses exactly what is claimed. A finding of anticipation requires that the publication describe or disclose all of the elements of the claims, arranged as in the patented device, functioning in substantially same way to produce substantially same results."

69 CJS Patents 58 Weight and Sufficiency further states: "The existence of a doubt defeats a claim of anticipation, every reasonable doubt being resolved against the party raising the question. The evidence must satisfy not only as to the time when the earlier method or device was made accessible to the public, but also as to its substantial identity with the method or device of the patent. To overcome the defense of anticipation, it is only necessary for the patentee to show some tangible difference between the invention and prior art."

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Remarks pertaining to 35 USC 103 Rejection of Scott.

The Examiner relies on Scott as showing a "switch 60 located on the exterior of structure 24 in box 56".

However, in column 5, lines 60-63, Scott states: "A water supply assembly 56 includes a weatherproof cabinet 58, a pump 20, a control box 60 and a power source 62."

Then, in column 6, lines 12-14, Scott states: "The control box 60 includes a timer device, a timer dial 64 and an on/off switch 66".

But, Fig. 2 describes "66" as referring to some other component than a "dial". It appears to be a wire-like component.

It is just completely uncertain whether there is a "switch" in Scott's apparatus or where it might be.

Applicants suggest that the electrical switch should be located "interiorly" of the structure.

Scott fails to designate where his switch should be located, and none of his structural views describe its location.

The Examiner states that "Providing the switch 60 inside of structure 24 is a mere relocation of parts".

I believe that the authenticity of Applicants' apparatus over that of Scott is clearly appropriate as I quote from an instruction found in the MPEP Sec 2144.08, page 2100-154: "In *Stratoflex, Inc v. Armstrong Corp.*, 713 F.2d. 1530, 1537, 218 USPQ 871, 877. (Fed. Cir. 1983), the court noted that 'the question under 35 U.S.C. 103 is not whether the differences [between the claimed invention and the prior art] would have been obvious' but whether the claimed invention 'as a whole' would have been".

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Remarks pertaining to 35 USC 103 Rejection on Banzato in view of McFadden

I respectfully take issue with the Examiner's statement that "Banzato discloses the limitations of the claimed invention with the exception of the water return line".

I pointed out above in the Remarks pertaining to the 35 USC 102 Rejection on Banzato the more conclusive differences between the system of Banzato and Applicants.

I believe in combing McFadden with Banzato the degree of obviousness is not as conclusive as the law requires.

I quote, 69 CJS Patents 87 Research References: "Obviousness must be established by clear and convincing evidence and each fact forming the factual foundation upon which a court bases its ultimate conclusion regarding the obviousness of claimed subject matter must be established by clear and convincing evidence."

McFadden states: "Also included in the fire protection system ±1 is a water recirculating system 30 for returning water from the lower base trough 28 to the roof conduit 20." And, he states: "This gutter is preferably covered by a screen 44 or the like to keep debris out of the gutter.

Applicants' return water system is completely different from that of McFadden, and Applicants' filter is clearly positioned in the water return line 44.

In replying to this Rejection, I again quote from the MPEP/ MPEP 706.02 Distinction between 35 U.S.C. 102 and 103: "The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C., the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made."

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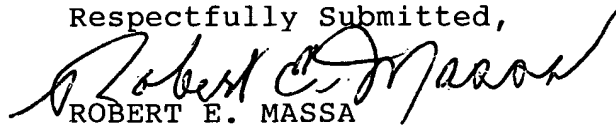
Remarks in Summary of the Response

In preparation of the Application for Allowance, I wish to state that Claims 1-17 have been canceled and replaced by New Claims 18-25, and that I believe that New Claims 18-25 clearly distinguish Applicants' Invention over the references cited, the patents to Scott, Van Lingen, Banzato, and McFadden, cited by the Patent Office, and comply with the Examiner's Objections.

For the reasons cited herein, Applicants believe that their invention is not described by any of the references cited, either singly, or in combination.

Therefore, Applicants respectfully request Allowance of their Application.

Respectfully Submitted,



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